

## REMARKS

In accordance with the foregoing, claims 1, 16 and 17 are amended. Claim 18 is added. No new matter is added. Claims 1 and 16-18 are pending and under consideration.

### CLAIM REJECTIONS UNDER 35 USC § 101

Claim 1 is rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter.

Applicants acknowledge with appreciation the telephone conversation with the Examiner on February 24, 2009, regarding the rejection under 35 U.S.C. §101. On the occasion, Applicant's representative pointed out that, as specified in the claim preamble, the method of claim 1 is performed by a support server. Applicant's representative brought to the Examiner's attention, a non-limiting embodiment of a support server illustrated in FIG. 1 of the specification. The specification describes that the support server 10 of FIG. 1 stores information (e.g., the customer management file 42 and the service map file 44), communicates with various devices outside the support server via a communication control unit 30, and performs information processing in a support processing unit 32 using the stored information and input received via the communication control unit.

The Examiner admitted that the support server is an apparatus, but alleged that according to precedential Supreme Court decisions (*Diamond v. Diehr* and *Gottschalk v. Benson*), and in light of recent application by BPAI, the apparatus must also perform a transformation. Applicant respectfully disagrees and argues below that such an application of the precedential decisions is incorrect.

In the recent decision *In Re Bilski*, the CAFC has put forth a new test (the "Machine-or-transformation" test) applicable for evaluating whether a process claim should be granted patent protection. According to this new test, which is consistent with the precedential Supreme Court decisions, a process is patentable subject matter if either is tied to a particular machine or apparatus, **OR** transform a particular article into a different state or thing. That is, both conditions are not required (it appears that the Examiner interprets the test as requiring both), but one **OR** the other.

As brought to the Examiner's attention during the informal interview, the method of claim 1 is performed by a support server and thus it is **tied to an apparatus**, satisfying the machine prong of the "machine-or-transformation" test. However, in order to more clearly specify the method to apparatus tie, claim 1 is amended herewith to specify that:

- the “receiving” operation recited in claim 1 is performed “by a transition request reception unit of the support server”,
- the “providing” operation is performed “by an after-transition service information presentation unit of the support server” using “a customer management file stored in the support server” and “a service map file stored in the support server”, and
- the “registering” operation is performed “by a service contract unit of the support server.”

The claim amendments are supported by the originally filed specification, for example, FIG. 1 and the corresponding description.

Furthermore, a person of ordinary skill in the art would recognize that the method of claim 1 has also the effect of at least altering “contents of a service stored in correlation with the telephone number in the management customer file” because “contents of an after-transition service correlated with the telephone number [is stored] in the management customer file.” Thus, the management customer file and the contents of the service stored in correlation with the telephone number are transformed when the “transition of service providers between portable telephone companies” occurs, “from a before-transition portable telephone company to an after-transition portable telephone company.” Thereby, the claimed method also meets the transformation prong of the new “machine-or-transformation” test.

During the informal phone interview, the Examiner also expressed the opinion that BPAI’s recent precedential opinions indicate that process claims are not patentable if only tied to a computer. Upon reviewing some of the recent BPAI decisions, Applicant respectfully submits that it appears that the BPAI has taken the position that specifying a computer is insufficient for a process claim involving an algorithm or a calculation based on a formula, because such a claim is directed to a non-patentable subject matter not to a process (see *Ex parte* Marius A. Cornea-Hasegan, Appeal 2009-4742). In the present application, claim 1 is not a mere algorithm or based on a calculation based on a formula, and therefore BPAI decision to deny patentability in such cases does not apply.

In view of the above arguments and claim amendments, Applicant respectfully requests that the rejection under 35 U.S.C. §101 be withdrawn.

#### **CLAIM REJECTIONS UNDER 35 USC § 103**

Claims 1, 16 and 17 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over JP 2002175431 to Namiki et al. (hereinafter “Namiki”).

*Applicant has noted that the machine translation of JP 2002175431 has been recorded in PAIR on October 2, 2008, under the label "Specification." Applicants disagree with characterizing the machine translation of JP 2002175431 as representing the Specification, and respectfully request the label to be corrected to reflect the content (for example, to "Foreign Reference").*

In the Amendment filed on September 5, 2008, Applicant argued that JP 2002175431 fails to anticipate "providing information about an after-transition service equivalent to a service contracted before transition **to the customer terminal.**" The outstanding Office Action indicates again (as in the previous Office Action) paragraphs [0060] and [0061] of Nakimi as providing relevant disclosure. These paragraphs are reproduced below for facilitating the following discussion:

[0060]A model change is performed like drawing 17 according to the various programs 11, 21, and 41, and performs the same entrepreneur selection (Step 100) as new sale first. And the input of the portable telephone number 304 currently assigned to the model concerning the change as the contract information 118 is urged (Step 302). The inputted portable telephone number 304 is notified to the sales server 4, and it refers for the track record of use (Step 306). An inquiry result is displayed on the display 48. And the notice 308 of a track record is notified to the terminal generalization server 3 based on the display of these reference like the case of new sale. The re-reception code 126 is published like the case of new sale as it is outside reference time, and the transaction 46 is adjusted.

[0061]If the terminal generalization server 3 checks the notice 308 of a track record which received (Step 310) and has track records, such as fee nonpayment, it will stop sale (Step 312), and if there is no track record which obstructs this contract, it will perform model selection (Step 102) or below like new sale. However, among the contract information 118, an address, a billing address, a name, a date of birth, etc. display the thing of the contract before corresponding to the portable telephone number 304, and the input of a changed part is urged to them. By using the result of a performance inquiry (Step 306), reference (Step 128) of contract information can be held simply, or can be omitted. In the case of the model change between the same communication enterprises, etc., it does not indicate by a telephone number (Step 136), but the same number as the used portable telephone number 304 is inputted into the cellular phone to ship, and is adjusted.

Namiki does not disclose that (1) information about an after-transition service equivalent to a service contracted before transition is provided (2) to the customer terminal, when (3) transition of service providers between portable telephone companies is performed by a support sever.

Relative to (1), Namiki discloses that a track record and contract information are obtained using the telephone number. The track record includes information about obstacles obstructing a new contract such as a fee non-payment, and the contract information includes an address, a billing address, a name, a date of birth, etc. However, neither the track record nor the contract information in Namiki teaches or suggests “contents of the service contracted before the transition” being recovered using the telephone number. Since Namiki does not acquire information about the service contracted before the transition, Nakimi does not anticipate or render obvious “information about an after-transition service equivalent to a service contracted before transition.”

Relative to (2), the paradigm of Namiki is fundamentally different from the environment in which the claimed method operates. In Namiki, a terminal in communication with a server computer, transmits contract information including device kind information, to a selling server, and the selling server displays and transmits the contract information received from the terminal to a collating system A related with the contract of the communication agent (see Namiki's abstract). According to claim 1, a support server in communication with a customer terminal mediates a transition of service providers between portable telephone companies. Thus, in Namiki, information is displayed at the server side or service provider side not at the customer terminal side. Therefore, Namiki does not anticipate or render obvious that the server provides the information about an after-transition service equivalent to a service contracted before **transition to the customer terminal**.

Relative to (3), Namiki refers to a terminal that mediates selling a portable telephone accompanied with a contract (see “PROBLEM TO BE SOLVED” section) or change of the portable phone with a newer model phone while the service provider remains the same (i.e., Company A), while the claim is a support method for transition of service providers between portable telephone companies is performed by a support sever.

In view of the above, Applicant respectfully submits that Namiki does not anticipate or render obvious the “providing” operation as recited in claim 1.

The Office Action admits that Namiki “does not explicitly disclose the before-transaction and after-transaction contracts being equivalent” (see page 4, lines 12-17 of the outstanding Office Action). However, the Office Action alleges that such an equivalence would have been obvious to a person of ordinary skill in the art. Applicant respectfully submits that the Examiner appears to fail to understand the invention and miss-states the claimed features.

Claim 1 recites that the support server who performs the claimed method “[provides]

information about an after-transition service equivalent to a service contracted before transition to the customer terminal." Further according to claim 1, the customer terminal sends and the support server receives "a service selection notifying the after-transition service selected **based on the information about the after-transition service equivalent of the service before transition.**" That is, claim 1 does not state that the before-transaction and after-transaction contracts are equivalent; but that the after-transition service is selected using information about the after-transition service equivalent of the service before transition, which information has been provided by the support server. The Office Action demeans and simplifies the features recited in claim 1. MPEP 2143.03 clearly specifies that "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In view of the above, claim 1 and claim 16 depending from claim 1 patentably distinguish over Namiki.

Based on the above discussion of the applied prior art teachings, claim 17 patentably distinguishes over the prior art at least by reciting:

providing information about an after-transition service equivalent to a service contracted before transition to the customer terminal, the information being based on contents of the service contracted before the transition recovered using the telephone number included in the request, from a customer file storing contents of services correlated with telephone numbers, and information on contents of the services provided by a service provider that the after-transition portable telephone company can use, registered in a service map file.

#### **NEW CLAIM 18**

New claim 18 is directed to a method performed by a support server connected to a customer terminal and portable phone service providers, for changing a provider of portable telephone service. The new claim is supported by the originally-filed specification. Claim 18 patentably distinguishes at least by reciting:

responding to a request to change a service provided by a first provider to a replacement service provided by a second provider, by generating and sending to a customer terminal that sent the request including a telephone number, information on services of the second provider that correspond to the service provided by the first provider, using a service description of the service received from the first provider, stored in the support server correlated with the telephone number, and information on available services of the second provider, stored in the support server.

## CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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